

Interview Summary

Application No.

10/674,892

Applicant(s)

REED ET AL.

Examiner

Sreeni Padmanabhan

Art Unit

1617

All participants (applicant, applicant's representative, PTO personnel):

(1) Sreeni Padmanabhan.

(3) Tom Kowalski.

(2) Barbara Badio. *

(4) Angela Collison, David Alcock, Dr John Normanton.

Date of Interview: 02 October 2007. and 4/10/07

Type: a) ☐ Telephonic b) ☐ Video Conference
c) ☒ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No.

If Yes, brief description: _____.

Claim(s) discussed: All claims.

Identification of prior art discussed: All patents and applications cited in the ODP rejections.

Agreement with respect to the claims f) ☐ was reached. g) ☒ was not reached. h) ☐ N/A.

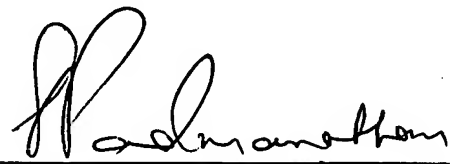
Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: See Continuation sheet.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN A NON-EXTENDABLE PERIOD OF THE LONGER OF ONE MONTH OR THIRTY DAYS FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

* Attended the 4/10/07 interview only.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.


Examiner's signature, if required

1. Applicants representatives stated that the Final rejection of 7/3/07 was improper for the following reasons: 1) Based upon applicants response of non obviousness due to unexpected results examiner had withdrawn several ODP rejections made in the previous Non-Final action, but maintained several other ODP rejections even though the reasons for making the ODP were the same as in the now withdrawn rejections; 2) Examiner used the term "etc, etc" and requested applicant to supply TD's over these patents and or applications. Applicants were not clear as to what patents and or applications the term "etc, etc" included. Applicant insisted that it was the examiners job to make all the rejections clearly and only then they would be able to respond.

Regarding issue number 1) raised by the applicants, I informed them that if I had examined the case I would have not withdrawn any of those ODP rejections. To this the applicants argued that the prior art taught a large genus of compounds and that there was no motivation to pick and choose their claimed compounds. I pointed out to them that their compound claims also claimed a large genus of compounds by claiming R1 and R2 to be independently anything other than H when one of R1 or R2 was H.

Regarding issue number 2) I agreed with the applicants and informed that I would request the examiner to withdraw the Finality and make all the rejections encompassed by the term "etc, etc".

Applicants then stated that would consider canceling all the compound claims and consider limiting their method claims to non-estrogenic compounds.

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To this I pointed out that some of the prior art would still hold as these prior art included estrogenic and non-estrogenic compounds, but that I will defer this to the examiner to make that decision.

Applicants on 10/3/07 filed a petition to withdraw the Finality of the previous Office action and also a request for a personal interview with the primary examiner.

On 10/4/07 the applicants were granted another interview wherein the primary examiner was also present. During this interview the same issues as of 10/2/07 were again discussed. Examiner informed them that if they withdrew the petition to withdraw the finality she would then reopen prosecution and issue a non-final action. If applicants presented only method claims with non-estrogenic compounds, examiner will also evaluate such claims on their merits and send out a non-final action.